

## R E M A R K S

Prior to entry of this Amendment:

- Claims **1-13 and 15-18** were pending in the present application
- Claims **1-13 and 15-18** stand rejected

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims **1-13 and 15-25** will be pending
- Claim **10** will be amended
- Claims **19-25** will be added
- Claims **1, 17, 18, 20, 21, 22, and 24** will be the only independent claims

### **A. RCE**

This Amendment and Response is being filed in response to a Final Office Action. A Request for Continued Examination (RCE), along with the appropriate fee, is being filed concurrently to ensure consideration of this Amendment and Response.

### **B. Clarification as to status of Claim 14**

We note that Claim 14 was rejected in the present Office Action. However, Claim 14 was not actually pending—it was canceled in the Amendment filed September 7, 2004. Accordingly, the Examiner's rejection of Claim 14 is moot and will not be addressed in this response. We reserve the right to dispute the Examiner's rejection of the claimed subject matter in the future.

### **C. Claim Amendments**

No new matter has been added by any amendment.

#### **C.1. Claim 10 has been amended to broaden its scope**

No new matter has been added, and no amendment was made for reasons relating to patentability. Removing “with the corresponding first identifier and the corresponding second identifier” has broadened the claimed subject matter of Claim 10.

**C.2.        New Claims 19-25 have been added**

Claims **19-25** have been added without prejudice. Claims **20, 21, 22, and 24** are independent. Claims **19-25** contain allowable subject matter, as discussed below. Claim **19** depends from independent Claim **1** and is allowable for at least the reasons stated in these remarks with respect to Claim **1**.

**D.        Section 103(a) Rejection**

Claims **1-3, 8-13, and 15-18** stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5960442 issued to Pickering (“Pickering”), and further in view of Lisa Guernsey, “You Can Surf, but You Can’t Hide,” New York Times, February 7, 2002 (“Guernsey”).

Claims **4-7** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Pickering and Guernsey and further in view of U.S. Patent No. 5812668 issued to Weber (“Weber”).

We respectfully traverse the Examiner’s Section 103(a) rejections.

**D.1.        Claims 3 and 13**

The Examiner has failed to establish a *prima facie* case of obviousness for Claims **3 and 13**.

**D.1.1.        Teachings of/Reliance on “Bossi” reference are fatally unclear**

The basis of rejection of Claims **3 and 13** is fatally unclear.

We do not understand the Examiner’s rejection of Claims **3 and 13**, as stated on page 4 of the Office Action (emphasis added): “Regarding claims 3 and 13, Pickering and Bossi et al. fail to teach the method comprising verifying good standing of a customer account of the second telephone.” To the best of our knowledge, a “Bossi” reference has not been cited in this application either by us or by the Examiner.

Given the Examiner’s brief reference to what “Bossi” does not teach, it is fatally unclear if or how the Examiner is relying on the “Bossi” reference with respect to either of Claims **3 and 13**. The rejection of Claims **3 and 13** fails for at least this reason.

**D.1.2. No evidence of features or motivation to modify references**

The Examiner has also failed to establish a *prima facie* case of obviousness because the Examiner has failed to provide evidence (i) that the features of Claims **3 and 13** were known or (ii) that one of ordinary skill in the art would have been motivated to provide for such features.

Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. Cardiac Pacemakers v. St. Jude Medical, 381 F.3d 1371, 1376 (Fed. Cir. 2004).

In contrast to the requirement to provide tangible evidence, with respect to Claims **3 and 13** the Examiner simply asserts: “this step is obvious because the service company wants to make sure that the customer is willing to pay for the service.” No evidence of record supports this assertion as to what a “service company” might want.

Thus, the Examiner’s conclusory assertion is not supported by substantial evidence of record and cannot support the obviousness rejection. Absent such objective evidence, we submit that the generalized advantage articulated by the Examiner must have been derived from our disclosure and/or improperly justified based on impermissible hindsight.

Further, even if the Examiner had provided objective evidence (as opposed to convenient assumptions about what was known) in support of what a hypothetical “service company” supposedly wants, there is no evidence of record that it would have been obvious, even in light of such a teaching, to provide specifically for the feature of *verifying good standing of a customer account of the second telephone*. The Examiner does not provide any reasoning supporting such a conclusion. “Recognition of a need does not render obvious the achievement that meets that need. There is an important distinction between the general motivation to cure an uncured disease (for example, the disease of multiple forms of heart irregularity), and the motivation to create a particular cure.” Cardiac Pacemakers, 381 F.3d at 1377.

The Examiner concedes that Pickering does not suggest *verifying good standing of a customer account of the second telephone*, as recited in Claim **3**. No other reference suggests any such feature; the Examiner does not assert otherwise. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claim **3**.

Confusingly, the Examiner directs the statements regarding a “service company” to Claim **13** as well as Claim **3**. Claim **13**, however, does not recite

*verifying good standing....* The Examiner appears to have ignored or misunderstood the recited step of Claim 13: *recording transmission of the status to the second telephone's customer account*. Nothing in the cited references appears to suggest any such feature or the desirability of providing for any such feature; the Examiner does not assert otherwise. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claim 13.

## **D.2. Independent Claims 1, 17, and 18**

We respectfully submit that independent Claims 1, 17, and 18 are not obvious in light of Pickering or Guernsey, either alone or in combination. First, no combination of Pickering and Guernsey teaches or suggests all of the features of the independent claims. Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of the independent claims.

Claims 17 and 18 incorporate the method of Claim 1 by reference and are considered allowable for at least the same reasons as discussed with respect to Claim 1.

### **D.2.1. The references do not disclose a text messaging feature of a telephone**

We do not understand the Examiner's asserted combination of Pickering and Guernsey, or how such a combination would provide for all of the features of independent Claim 1. In particular, nothing in the Examiner's rejection explains how any combination Pickering and Guernsey could teach a text messaging feature of a telephone.

The Examiner asserts: "Pickering fails to teach the status information indicating a text messaging feature is using by [sic] that entity (e.g., the status information indicates that the entity is busy because the entity is using the Internet)." Office Action, pages 2-3.

We do not understand the source or relevance of the parenthetical example. We do not believe that Pickering teaches generally that "using the Internet" somehow has something to do with whether an "entity" is "busy" or whether a text messaging feature is in use. Pickering does not appear to suggest indicating that an "entity" is "busy" if he is "using the Internet."

The Examiner continues:

However, Guernsey teaches that the technology is able to provide many people that a buddy is online (page 2, 4<sup>th</sup> paragraph). It is noted that when the status of the buddy is notified, it is read into the limitation “a text messaging feature of the first telephone is used”. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of instant messaging as disclosed by Guernsey into the system disclosed by Pickering in order to save time for a caller who intends to make a call to a busy line of a particular person.

[Office Action, page 3].

We note that, contrary to what the Examiner may be asserting, Guernsey does not appear to disclose *a text messaging feature of a telephone*.

Also, the discussion of “instant messaging” in Guernsey does not appear to be related to use of a telephone, telephony, or to suggest the desirability of providing for an instant messaging feature on a telephone.

Accordingly, the Examiner has not provided substantial evidence that any combination of the cited references suggests a text messaging feature of a telephone (much less receiving a status that indicates whether a user of a first telephone is using a text messaging feature of the first telephone). No *prima facie* case of obviousness has been established for independent Claim 1.

#### **D.2.2. No motivation to combine Pickering and Guernsey**

In addition, the Examiner has failed to provide tangible evidence of a motivation to provide for the asserted combination of Pickering and Guernsey.

As discussed above, Guernsey does not actually appear to teach what the Examiner asserts with respect to use of an instant messaging system with a telephone.

The Examiner’s asserted motivation is:

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of instant messaging as disclosed by Guernsey into the system disclosed by Pickering in order to save time for a caller who intends to make a call to a busy line of a particular person.

[Office Action, page 3]. We do not believe that the evidence of record supports the asserted motivation.

Also, we do not understand what reference the Examiner is relying on as suggesting the desirability of saving time for a caller who intends to make a call to a busy line of a particular person. We also do not understand what incorporating “instant messaging” in Pickering would have to do with the as-yet-unsupported motivation to “save time for a caller who intends to make a call to a busy line.”

We also do not understand how receiving a status indicating that a user of a first telephone is using a text messaging feature of the first telephone, as generally recited in Claim 1, would meet the goal of the proposed motivation (i.e., to “save time for a caller who intends to make a call to a busy line”). For instance, it is not clear what whether a person’s “line” is “busy” has to do with the desirability of modifying Pickering to incorporate “instant messaging.”

Accordingly, we submit that the Examiner has not provided substantial evidence of a motivation to provide for a feature of *receiving a status, from the first telephone, which indicates whether the first telephone is using a text messaging feature of the first telephone*, as recited in Claim 1.

We submit that Claim 1 and all claims dependent from it contain allowable subject matter.

### **D.3. Claims 9 and 10**

The Examiner has failed to establish a *prima facie* case of obviousness for Claim 9 (or Claim 10 dependent therefrom).

According to some embodiments of the present invention, an entity (e.g., a subscriber at a monitoring client telephone) may monitor a status change of a particular predetermined condition. For example, a subscriber may choose to monitor the “busy” status of a monitored client telephone. Alternatively, a subscriber may choose to monitor when the person at a monitored client telephone enters a DTMF code indicative of a working status. See, e.g., Specification, page 16. One of ordinary skill in the art will recognize that these examples are purely illustrative of different status changes, and that alternative embodiments of the present invention may include status changes of other predetermined conditions.

Claim 9 recites *wherein the step of receiving a request includes receiving a request to notify the second telephone when a status change of a predetermined condition of the first telephone occurs*. No combination of the cited references suggests such a feature or the desirability of providing for such a feature.

The Examiner indicates that Pickering teaches this feature at Column 5, lines 20-23. The cited portion reads: “When (and if) access is granted, status information on John Doe is passed over the Internet to PC 112 at station 110, and the information line on John Doe is immediately updated.” The Examiner does not indicate how the Examiner construed the claims or interpreted the cited portion as teaching the claimed subject matter.

We dispute that the cited portion (or any portion of Pickering or Guernsey) teaches the claimed feature. This portion does not suggest a predetermined

condition of a first telephone, a status change of a predetermined condition of the first telephone, or receiving a request to notify a second telephone if such a change occurs, as recited in Claim 9. Nothing in Pickering suggests the desirability of requesting to be notified of a change in a particular condition.

Further, nothing in any of the cited references remotely hints at storing the status change of the predetermined condition, as recited in Claim 10.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claims 9 and 10.

#### D.4. Claim 16

The Examiner has failed to establish a *prima facie* case of obviousness for Claim 16.

Claim 16 recites a feature of *receiving an acknowledgment from the second telephone of a successful transmission of the status*. No combination of the cited references suggests such a feature or the desirability of providing for such a feature.

The Examiner asserts:

it is inherent that Pickering further teaches...receiving an acknowledgment from the second telephone of a successful transmission of the status because when a signal is sent over a telecommunication network an acknowledgment of receiving the signal should be the next step in the network.

[Office Action, page 4].

“[A] prior art reference may anticipate without disclosing a feature of the claimed invention if that characteristic is necessarily present, or inherent, in the single anticipating reference.” Schering Corp. v. Geneva Pharm., Inc., 339 F.3d 1373, 1377 (Fed. Cir. 2003). Inherent anticipation requires that the missing descriptive material is necessarily present, not merely probably or possibly present, in the prior art. Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (emphasis added).

We submit that *receiving an acknowledgment from the second telephone of a successful transmission of the status* is not necessarily present in Pickering.

We read the Examiner’s statement as conceding that Pickering does not explicitly teach such acknowledgment.

We read the Examiner’s statement (despite its assertion to the contrary) as indicating that the Examiner does not really believe that such acknowledgment is “inherent” or necessarily present in Pickering. As noted above, inherency requires

the descriptive material is necessarily present, not merely probably or possibly present. The Examiner asserts that such acknowledgment “should be the next step.” The Examiner does not (and cannot) assert that in the Pickering system such an acknowledgment is necessarily present.

To the extent the Examiner believes it would be obvious to modify the Pickering system to provide for such acknowledgment, no tangible evidence of record has been provided in support of any assertion that it was either (i) known or (ii) would have been considered desirable to one of ordinary skill in the art to provide such acknowledgment in combination with the cited references.

The Examiner accordingly has failed to establish a *prima facie* case of obviousness with respect to Claim 16.

For at least the reasons stated above, we respectfully request allowance of Claims 1-13 and 15-18.



**E. Newly-Added Claims 19-25 Are Patentable Over the Cited References**

Newly-added Claims 19-25 are patentable over Pickering, Guernsey, and Weber for at least the reasons presented herein.

**E.1. Claim 19**

Claim 19 depends from independent Claim 1 and is allowable for the reasons stated above with respect to independent Claim 1. Claim 19 also recites additional features that are not suggested by any combination of the cited references. In particular, the references do not suggest blocking calls to a telephone based on a GPS location of the telephone, much less establishing such blocking. Accordingly, the references cannot teach or suggest the following:

- *receiving a signal from the first telephone*
- *determining a GPS location of the first telephone based on the received signal*
- *establishing that while the first telephone is at the determined GPS location, calls to the first telephone from the second telephone are to be blocked*

as recited in new Claim 19.

**E.2. Claim 20**

Various embodiments of the present invention allow for establishing that a particular location is a blocked location or that a telephone at the location is unavailable (*e.g.*, at the request of a user of the telephone). A user may provide a code, for example, indicating that at present location of a telephone is to be established as a blocked location. In one embodiment, once a telephone (*e.g.*, a cellular telephone) associated with a blocked location moves from the blocked location (*e.g.*, becomes available), the change in status may be automatically provided to a monitoring client. For instance, a user may designate a particular building as a blocked location, and the status of “unavailable” may be updated automatically once the user leaves the building. For some general examples, please see Specification, page 20. Of course, all such examples are not limiting to the subject matter defined by the claims as understood by one of ordinary skill in the art.

None of the cited references suggests automatically indicating a telephone is available for receiving calls based on determining that the telephone has moved from a blocked location. Accordingly, none of the cited references suggests *in*

*response to determining that a first telephone has moved from the first location (for which it was established calls to the first telephone from the second telephone would be blocked), automatically transmitting to a second telephone a status indicating that the first telephone is available to receive calls, as generally recited in Claim 20. Like independent Claim 1, new independent Claim 20 also recites steps of receiving an indication of a second telephone that is authorized to monitor a first telephone and receiving a request from the second telephone to monitor the first telephone.*

**E.3. Claim 21**

No combination of the cited references suggests preventing a call from connecting to a cellular telephone based on the location of the cellular telephone, much less in which the location of the cellular telephone is determinable. Specifically, no combination suggests all of the features of Claim 20, including:

- *based on the signal, establishing that calls to the cellular telephone are to be blocked while the cellular telephone is in the first location*
- *determining that the cellular telephone is at the first location*
- *receiving an incoming call to the cellular telephone while the cellular telephone is at the first location*
- *preventing the incoming call from connecting to the cellular telephone based on the first location*

**E.4. Claims 22 and 23**

No combination of the cited references suggests determining whether to block at least one call to a wireless telephone while the wireless telephone is at a determined GPS location, much less in which the GPS location of the wireless telephone is determinable based on a signal received from the wireless telephone. No combination suggests all of the features of Claim 22, including:

- *receiving a signal from a wireless telephone*
- *determining a GPS location of the wireless telephone based on the received signal*
- *based on the determined GPS location, determining whether to block at least one call to the wireless telephone while the wireless telephone is at the determined GPS location*

Claim 23 depends from Claim 22 and is allowable for at least the same reasons.

**E.5.           Claims 24 and 25**

No combination of the cited references suggests either (i) establishing, based on a preference of a user, that a cellular telephone is to be unavailable for receiving calls while the cellular telephone is at a first location or (ii) in response to determining that the cellular telephone has moved from the first location, automatically transmitting to at least one telephone an indication that the cellular telephone is available to receive calls, as generally recited in independent Claim 24.

Claim 25 depends from Claim 24 and recites further features not suggested by the cited references. In particular, the references do not teach or suggest any of the features of:

- *receiving an incoming call to the cellular telephone*
- *receiving a second signal from the cellular telephone*
- *determining a current location of the cellular telephone based on the second signal*
- *blocking the incoming call to the cellular telephone if the current location is the first location*

For at least the reasons stated herein, we respectfully submit that new Claims 19-25 are allowable.

**F. Authorization to Charge Appropriate Fees & Petition for Extension of Time to Respond**

We understand that a TWO-month extension of time to respond to the Office Action is necessary. Please grant a petition for any extension of time required to make this Response timely.

If necessary, please charge any appropriate fees necessary per the following information:

Charge: \$225.00

Deposit Account: 50-0271

Order No.: 02-004

Please credit any overpayment to the same account.

*A duplicate copy of this authorization is enclosed for such purposes.*

**G. Conclusion**

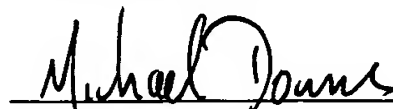
It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mdowns@walkerdigital.com](mailto:mdowns@walkerdigital.com).

Respectfully submitted,

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Date



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